

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TERAD-11-US

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on _____

Signature _____

Typed or printed name _____

Application Number

10/749,264

Filed

12/31/2003

First Named Inventor

LEGATE, Ian.

Art Unit

3663

Examiner

Tuan C. To

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Bruce D. Rubenstein #39,349/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Bruce D. Rubenstein

Typed or printed name

☐ attorney or agent of record.

Registration number _____

781-274-0202

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Registration number if acting under 37 CFR 1.34 39,349

November 9, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re:	LEGATE, Ian et al.	Patent Application Docket Number: TERAD-11-US
Serial No:	10/749,264	Group: 3663
Filed:	12/31/2003	Examiner: Tuan C. To
For:	TELEMATICS-BASED VEHICLE DATA ACQUISITION ARCHITECTURE	

November 9, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is in response to a FINAL Office Action mailed August 9, 2007, in connection with the above-identified patent application. A Notice of Appeal, corresponding fee, and Request Form PTO/SB/33 are submitted herewith.

The status of the application is as follows. Claims 1-4 and 9-13 are pending. Claims 1 and 9 are independent. All of the pending claims have been rejected at least twice. One request for continued examination (RCE) has already been submitted.

CLAIM 1

Claim 1 has been rejected under 35 U.S.C. 103(a) as being unpatentable based on Klausner et al. (US 6,748,305 B1, hereinafter, "*Klausner*") in view of Seashore et al. (US 5,916,286 A, hereinafter, "*Seashore*"). However, the FINAL Office Action and previous office actions have failed to make a *prima facie* case for rejecting claim 1 based on these references.

Applicants request that the Panel review and consider the arguments already presented in Applicants' response dated May 21, 2007. The relevant portions span page 4, ¶6 through page 6, ¶4.

It can be seen from Applicants' previous arguments that claim 1 distinguishes over *Klausner* and *Seashore* in a significant way, which the Examiner has not addressed. Claim 1 clearly recites a "retrieving" step that is performed "responsive to the requests for vehicle parameter data from [a] telematics application." Nowhere does the final or any previous office action indicate where *Klausner* or *Seashore* discloses this feature. In fact, the Final Office Action indicates something different, that *Seashore* teaches retrieving vehicle data responsive to input from a user (page 4, ¶1 of the Final Office Action).

Not only do the final and previous office actions fail to identify this "retrieving step" in the references, they also fail to give any other reason that this feature might be obvious in the context of claim 1. The fact that the "retrieving" step is "responsive to the requests for vehicle parameter data from the telematics application" is an important aspect of claim 1; however, it has been ignored in the obviousness analysis.

Therefore, the Examiner has failed to make a *prima facie* case for rejecting claim 1. Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Claims 2-4 depend from claim 1. Since the rejection of claim 1 is improper, the rejections of claims 2-4 are also improper and should be withdrawn.

CLAIM 9

Claim 9 has also been rejected under 35 U.S.C. 103(a) as being unpatentable based on *Klausner* in view of *Seashore*. However, as with claim 1, the FINAL Office Action and previous office actions have failed to make a *prima facie* case for rejecting claim 9 based on these references.

Applicants request that the Panel review and consider the arguments presented in Applicants' response dated May 21, 2007, particularly the last paragraph of page 6 through the third paragraph of page 7.

Claim 9 recites a step of "requesting vehicle parameter data by the telematics application" and a step of "accessing, responsive to the step of requesting vehicle parameter data, a database that stores data bus information for a plurality of different vehicle makes."

At page 5, ¶2 of the Final Office Action, the rejection states that *Klausner* fails to disclose this latter step ("Klausner et al. fails to include 'accessing, responsive to the step of requesting vehicle parameter data, a database that stores data bus information for a plurality of different vehicle types'"). The rejection then turns to *Seashore*. Despite an apparent effort to complete the rejection, however, no matching element is found. To the contrary, the Examiner states that *Seashore* teaches retrieving vehicle data "according to an input from a user." This is different from accessing a database "responsive to [a] step of requesting vehicle parameter data" by a telematics application. There is a substantial gap between these two concepts, and the Examiner has not bridged the gap in the rejection.

Therefore, the Examiner has failed to make a *prima facie* case for rejecting claim 9. Therefore, the rejection of claim 9 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Claims 10-13 depend from claim 9. Since the rejection of claim 9 is improper, the rejections of claims 10-13 are also improper and should be withdrawn.

Conclusion:

Applicants contend that the claims of the instant application clearly distinguish over *Klausner* and *Seashore* and are ready for allowance. A favorable response from the Panel is earnestly solicited.

Respectfully Submitted,

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